

## **REMARKS/ARGUMENTS**

The application has been carefully reviewed in light of the December 7, 2004 Office Action. In that Office Action, claims 27, 28, 30-32, 41, 42, 44-46 and 48 were rejected as being anticipated by Hebbecker (U.S. Pat No. 6,693,544). Claims 29, 33-37, 43 and 49 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hebbecker. Claims 38 and 47 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hebbecker in view of Carides et al. (U.S. Pat. No. 6,106,932). In light of the foregoing amendments, and the following remarks, Applicant respectfully requests reconsideration and reexamination of the Application.

### **§ 102 REJECTIONS**

As indicated above, claims 27, 28, 30-32, 41, 42, 44-46 and 48 were rejected under 35 U.S.C. § 102(e) as being anticipated by Hebbecker. Hebbecker is directed to an electronic identification tag or card which may be equipped with a rupture joint. The electronic identification dog tag has two sections which have a mirror-inverted design, and, in which, the same data is stored in the same manner. The tag or card is provided with punch holes for a necklace. Moreover, visually readable data, such as a personal identification number, blood type, a nation and name, is introduced into both sections. (See, Abstract).

As described in the Background section of Hebbecker, identification tags for people such as soldiers, militia, border patrol, national guard and the like are available and typically are made of sheet metal having two symmetrical halves which are separable by a predefined rupture groove. The tag is worn around on a around the neck and includes the individual's nationality, personal identification number, blood type and the like which are engraved into each of the two halves. In the event of death, one half is broken off and used to identify the person in question, and the other half remains on the body. Hebbecker indicates that data stored in such conventional identification tags no longer meets the need of a modern high-tech army. Hebbecker describes that the soldier is considered to be a part

of a weapons system as evidenced by his ability, apart from special training such as parachute training and specific competencies. Additional information is useful such as driver's license, knowledge, medical dispositions, vaccinations and allergies, and the like which are increasingly required for rapid troop deployment.

Hebbecker describes, in the Detailed Description of the '544 patent (col. 3-4) that his identification card or tag has a main directory which includes global hard data, including personal identification number, nation, name and blood type. Other information such as training of the person, qualifications of the person, etc. are also in the memory. In the drawings of the Hebbecker patent, FIGS. 2-B, 2-D and 2-E illustrate such an electronic dog tag having two halves and a rupturable joint 7. In particular, FIGS. 2-B and 2-D illustrate an electronic dog tag having integrated or embedded memory or microprocessor chips 4 and 4'. As discussed in column 4, lines 5-30, these identification tags include the integrated or embedded memory or microprocessor chips 4 or 4' which contain the same stored data and exhibit the same structure. In FIG. 2-E, the tag has only a single memory or processor chip 4, and on the other side of the rupture joint is engraved or embossed a portion or all of the data stored in the memory or microprocessor chip and introduced so as to be visually readable (col. 4, lns. 32-38).

In contrast, the present invention is directed to a multi-purpose card which includes a first and second redemption or charging means in the form of a first or second integrated circuit chips. These chips are positioned on the card such that they can be selectively charged or redeemed. For example, the multi-purpose card can, as described in the Specification, be both a debit and a credit card issued from the same or different financial companies or banks. Thus, instead of having to carry a separate debit and credit cards, a single card can accomplish the same purpose. Similarly, a MasterCard and VISA could be contained in the same card, each integrated circuit chip representing either the VISA or MasterCard redemption means. The chips are placed on opposite sides of the card, or are spaced apart from one another that they can be separately inserted through a reader so

as to selectively only charge or redeem against only one of the integrated circuit chips, as described in the Specification.

For anticipation, there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d 1565, 18 USPQ2d 1001, 18 USPQ2d 1896 (Fed. Cir. 1991). Applicant respectfully submits that one of ordinary skill in the field of the invention would view significant differences between the claimed invention directed to a charge or redemption card and the Hebbecker reference which discloses an electronic dog tag for use by military personnel.

For a prior art reference to anticipate in terms of 35 USC § 102, every element of the claimed invention must be identically shown in a single reference. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). Moreover, in determining anticipating, functional language, preambles, and language in “whereby”, “thereby”, and “adapted to” clauses cannot be disregarded. *Ipac-Tec, Inc. v. Amerace Corp.*, 903 F.2d 796, 14 USPQ2d 1871 (Fed. Cir. 1990).

Every element of the claimed invention is not identically shown in the Hebbecker reference. For example, referring to independent claim 27, “a wallet-sized card” is recited. There is no disclosure whatsoever in Hebbecker reference to support this proposition. In fact, traditional dog tags are much smaller than a wallet-sized card.

Moreover, independent claims 27 and 41 recite “first and second redemption charging means in the form of first and second integrated circuit chips, each integrated circuit chip containing information relating to a different entity”. Hebbecker does not disclose, teach or even suggest such a limitation. In fact, Hebbecker teaches exactly the opposite of this in that the information contained in the chips 4 and 4' or engraved or otherwise placed on the separate halves of the electronic dog tag “contain the same stored data and exhibit the same structure” (col. 4, Ins. 10-12). This is due to the fact that this information pertains to the same soldier and must be identical in Hebbecker.

Independent claims 27 and 41 also recite “whereby the multi-purpose card may be used for different transaction or purposes by selectively passing the first or second integrated circuit chip through a reader thus redeeming or charging to the selected entity”. There is no discussion or teaching or suggestion whatsoever in the Hebbecke reference of this limitation.

Accordingly, Applicant respectfully asserts that Hebbecke fails to anticipate independent claims 27 and 41, and their dependent claims (28, 30-31, 42, 44-46 and 48).

### § 103 REJECTIONS

In the Office Action, the Examiner states “ Hebbecke discloses the claimed invention except for the claimed location as set forth in the claims. It would have been obvious to the one of ordinary skill in the art at the time the invention was made to locate the chip elements in the claimed location, since it has been held that the rearranging of parts of an invention involves only routine skill in the art”. Applicant respectfully disagrees with this assertion. In the present invention, the placement of the chips, for example, on opposite sides of the base layer as recited in independent claim 34, enable each chip to be passed through a reader independent of the other chip, so as to selectively redeem or charge the selected entity. When on the same side of the base layer, the integrated circuit chips must be spaced apart in some fashion so that only one integrated circuit chip is read by a reader, and not both. Thus, this invention is not merely a rearranging of parts which is retained to one skilled in the art, but as one skilled in the art would readily appreciate the placement is critical to the selective charging or redeeming to the selected one of the entities represented on the card. Applicant respectfully asserts that the Examiner has not met his burden in rejecting this aspect of the invention.

With respect to claim 33, 48 and 49 “Official Notice” was taken that it would have been obvious to one having ordinary skill in the art at the time the invention was made to use peel-off coupons on the base layer of Hebbecke since the use of such is old and well-known in the art.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references when combined must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicant's disclosure. M.P.E.P. §2143 (citing In re Vaeck, 20 USPQ 2d 1438 (Fed.Cir. 1991)).

Applicant respectfully submits that a *prima facie* case of obviousness has not been met. There is no suggestion or motivation in the Hebbecker reference or in the knowledge merely available to one of skill in the art to modify the Hebbecker reference as suggested by the Examiner. Nor is there reasonable expectation of success. Applicant asks, "what purpose would peel-off coupons have in a dog tag for a soldier?" The answer to one of ordinary skill in the art would be "none". Applicant cannot conceive of a situation where peel-off coupons would be used on a dog tag or other identification tag. Even if there were a possible such use, such peel-off coupons would be rendered useless by the harsh conditions in which soldiers find themselves as the peel-off coupons would most surely become displaced and lost over time. Lastly, the teaching or suggestion to make the claimed combination and the reasonable expectation of success is not found in the prior art, but rather is based on Applicant's disclosure.

The mere fact that a prior art structure could be modified to produce the claimed invention would not have made the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 23 USPQ 2d 1780 (Fed. Cir. 1992). Applicant believes that impermissible hindsight was used in reconstructing references in an attempt to reject the claims of the present application.

In light of the foregoing, Applicant respectfully asserts that claims 29, 33-37, 43 and 49 are not rendered obvious and unpatentable over Hebbecker.

Claims 38 and 47 were rejected as being unpatentable over Hebbecke in view of Carides et al. The Examiner correctly asserts that Hebbecke does not disclose a scratch-off foil treatment. Carides et al., teaches the use of a scratch-off foil treatment to obscure indicia.

The Examiner has failed to establish the first basic criteria of a *prima facie* case of obviousness: that there must be some suggestion or motivation in either the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. The mere fact that the references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. M.P.E.P. §2143.01 citing *In re Mills*, 16 USPQ 2d 1430 (Fed. Cir. 1990). In fact, the references cannot be combined or modified as suggested by the Examiner, as this would frustrate the intended purpose of Hebbecke, that the embossed or engraved information be "visually readable". The scratch-off foil treatment would frustrate this purpose and have no other beneficial purpose. Thus, the Examiner has failed to establish the second basic criteria of a *prima facie* case of obviousness. Lastly, Applicant asserts that the suggested modification is based on Applicant's disclosure and not on the reasonable expectation of success found in the prior art or the teachings or suggestions of making a claim combination in the references.

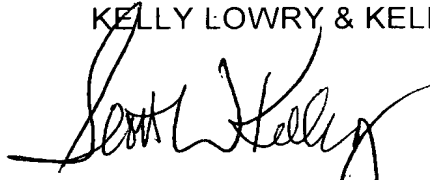
Accordingly, Applicant respectfully submits that claim 38 and 47 have been improperly rejected under the non-analogous references of Hebbecke and Carides, et al. Moreover, neither Hebbecke nor Carides et al., discuss whatsoever the problem solved by the present invention. In the rare case where the prior art does not appreciate the existence of the problem solved by the invention, the applicant's recognition of the problem is, in itself, strong evidence of the non-obviousness of the invention. *In re Nomiya et al.*, 184 USPQ 607, 612-613 (CCPA 1975).

## CONCLUSION

In light of the foregoing remarks, Applicant respectfully submits that claims 27-49 are patentably distinct from the cited references and "Official Notices", and thus in condition for allowance, notice of which is hereby respectfully requested.

Respectfully submitted,

KELLY LOWRY & KELLEY, LLP

A handwritten signature in black ink, appearing to read "Scott W. Kelley", written over the printed name and registration number.

Scott W. Kelley  
Registration No. 30,762

SWK/maf  
6320 Canoga Avenue, Suite 1650  
Woodland Hills, California 91367  
(818) 347-7900